

No. 10,334

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit 3

SAM SCHNITZER, HARRY J. WOLF, ROSE
SCHNITZER and JENNIE WOLF; indi-
vidually, and as a co-partnership, do-
ing business under the name and
style of Alaska Junk Co.,

Appellants,

vs.

CALIFORNIA CORRUGATED CULVERT CO.
(a corporation), and LEO T. CROW-
LEY, Alien Property Custodian of the
United States,

Appellees.

Upon Appeal from the District Court of the United States
for the District of Oregon.

BRIEF FOR APPELLEES.

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SAM SCHNITZER, HARRY J. WOLF, ROSE SCHNITZER and JENNIE WOLF; individually, and as a co-partnership, doing business under the name and style of Alaska Junk Co.,

Appellants,

vs.

CALIFORNIA CORRUGATED CULVERT CO. (a corporation), and LEO T. CROWLEY, Alien Property Custodian of the United States,

Appellees.

Upon Appeal from the District Court of the United States
for the District of Oregon.

BRIEF FOR APPELLEES.

JURISDICTION OF THE DISTRICT COURT.

On the question of jurisdiction, just one additional fact may be mentioned specifically. All of the defendants are inhabitants within the jurisdiction of the trial Court and have an established place of business in such district and are charged by the complaint to

Italics supplied unless otherwise stated.

have committed acts of infringement in said district, which facts, save and except the charge of infringement, are admitted by the answer (Par. II and III, T. R. 8). Jurisdiction of the District Court is, therefore, further predicated on Sec. 48, *Judicial Code* (28 U. S. C. A. Sec. 109).

FURTHER STATEMENT OF THE CASE.

While portions of appellants' statement of the case depart from a statement of facts to indulge in argument, it does give generally correct statements of the parties, the substitution of the Alien Property Custodian for original plaintiff and patentee Karl Lanninger, and the issues involved of validity and infringement of claim 3 of Letters Patent No. 1,747,942, granted February 18, 1930, to Lanninger. Legal title in plaintiffs is admitted, as well as license to, and corporate status of plaintiff California Corrugated Culvert Co. (T. R. 8 and 34). The statement of the case by appellants is controverted in the assertion on page 8 that " 'frictionally retaining the flange in the groove of the sleeve' is the root from which the claim of infringement grows", whereas claim 3 is a combination claim, and the basis for the claimed infringement is the practice of the invention of that combination. The statement of appellants' brief (page 9) is controverted, to the effect that defendants alleged infringing structures are made responsive to Pierce patent No. 1,945,293, granted January 30, 1934 (Exhibit 22, T. R. 387-390), since that patent does not

have a word of disclosure that the Pierce patent is for a flexible joint, whereas the alleged infringing structures 3 and 48, and 8 and 47 are flexible joints.

The invention of the Lanninger patent involved in this action is a flexible joint in connection with pipes, whereby a string of unthreaded pipe sections may be connected and disconnected without use of bolts, nuts or use of tools and yet maintains a tight leak-proof flexible joint between the pipe sections so that a portable pipe system may be installed over irregular ground and laid around angles or obstructions. While the patentee did not limit the patent to any particular use, having stated that the joint was in "a line of conduits especially designated for conducting water or steam", the evidence in this case centered around the specific use of the invention for "showering and irrigating" purposes, for which the plaintiff California Corrugated Culvert Co. has an exclusive license (Exhibit 13). As shown by the evidence (T. R. 353-356), it was unknown prior to Lanninger's patent (1930) to provide a flexible connectible and disconnectible joint in a line of unthreaded pipe, even regardless of his much earlier application date of October 8, 1923. He was a pioneer in a new conception of making possible the irrigation of unlevelled ground by a portable irrigation system of rigid pipe which could be moved from place to place in a field or transported from field to field, or removed from a field for plowing or cultivation. It permitted irrigation without leveling the land and thus denuding the top soil in the high places only to scrape it into the low places in a leveling process. It thereby brought into practical produc-

tivity vast areas which had not theretofore been irrigable, firstly because of uneven topography or secondly because the laying of separate strings of permanently installed pipe in parallel rows every fifty feet (T. R. 353), would make the cost prohibitive. The defendants have manufactured and sold the devices of Exhibit 48 (also the similar Exhibit 3) and Exhibit 47 (also the similar Exhibit 8), with additional pipe length installed at the respective ends thereof (T. R. 32), for irrigation purposes (T. R. 38).

The foregoing are the principal facts and it is believed other facts discussed are collateral thereto.

**SPECIFICATION II—THE INVENTION DESCRIBED IN
LANNINGER PATENT.**

In carrying out the purposes of the invention, the patentee described his invention (Exhibit 11, T. R. 383-386) as a

“line of conduits especially designed for conducting water or steam”, and “consists of pipes which are held together by means of sleeve-like coupling casings with rubber packing cups” (page 1, lines 1 to 8).

“On account of the rigidity of the coupling casing it is, however, very difficult(y) to insure the l(t)ightness of the joint between the coupling and the casing. According to the invention this difficulty is overcome by using the elastic packings through which not only is a tight joint capable of being maintained, but a certain degree of flexibility is imparted to the pipe line” (page 1, lines 19-27).

It will be noted that flexibility is provided by the elastic packing member.

“The very strong vertical flange on the packing cup permits of a specially *simple fixation* as it is inserted and clamped in a groove of the coupling sleeve.” (page 1, lines 23 to 30.)

But the patentee does not limit the invention to a mechanically operated clamp to form the groove and engage the flange of the packing member, since he provides elsewhere that the “flange of the packing is held in a recess” (page 1, line 60), and in Figs. 1, 3 and 4 he distinctly shows the flange b^2 of the packing “held in a recess e ” without other mechanically operated clamp.

One end of the sleeve has a length of pipe attached thereto to form a unit in the “line of conduits”.

“*The other neck of the coupling sleeve is also cylindrical but smooth so that the end of the other pipe can be inserted through this neck and through the hat-shaped rubber packing. The flange of the packing is held in a recess e .*” (page 1, lines 56-61.)

There is then provided a tight fit of the rubber cup on the inserted pipe wall, though none of the parties to this action have employed grooves in the free cylindrical part of the packing, nor is claim 3 limited in that respect.

“In order to facilitate the *tight fitting* of the rubber cup on the pipe wall, grooves are arranged in the cylindrical part of the same.” (page 1, lines 61-64.)

The sleeve of one pipe is then connectible with the inserted pipe by a hingedly securing means. This is a means for relatively securing the sleeve and inserted pipe end, while cooperating to maintain the flexibility heretofore described as provided by the elastic packing, and thus provide for a continuous flexible pipe line over irregular ground. The patentee says:

*“The sleeve is connected with this second pipe by means of a hinge. * * * The easy movement of the hinge and the ample play of the cotterpin in the borings of the hinge further increase the flexibility of the joint of the pipes and the facility of this joint to adapt itself to the irregularities of the ground and the available space.”* (page 1, lines 64-75.)

The patent provides, as an alternative or optional form only, that the flange of the packing *could* be “clamped” adjustably in the groove of the sleeve. In all figures of the drawings the packing flange is shown as frictionally held in the sleeve groove, except in one section of Fig. 3, where it is shown adjustably mechanically clamped. At page 1 the patent states:

“The packing could be adjustably mounted in the casing as shown in Fig. 3. In this case, the sleeve and neck are composed of two parts between the adjacent threaded ends of which the flange of the cup-shaped packing is clamped.” (page 1, lines 85-90.)

That the patentee was referring to inserting unthreaded pipe ends into the sleeve and packing member is demonstrated by the illustration of all the draw-

ings and the use of the term "the rough pipe ends" in describing Fig. 4. (page 1, lines 91-96.)

THE QUALITY OF INVENTION.

Every validly patented invention must involve a new inventive concept. The structural elements employed to concretely demonstrate the usefulness of the new concept are merely an idea of means, but they are not the invention. The structural elements may be highly involved or extremely simple, but if a new, useful and meritorious inventive concept is present, that is the true invention. Mere mechanical skill may often provide a change of structure, but can never be credited with producing a novel mental concept.

And so, the Circuit Court of Appeals, Third Circuit, in sustaining the Boyce motometer patent which merely placed a thermometer in a radiator cap of an automobile and provided an exterior sight-support for it, said the device was mechanically very simple, but it embraced a new concept.

Pyrene Mfg. Co. v. Boyce (C. C. A. 3, 1923), 292 Fed. 480, 481 (cert. den. 263 U. S. 723) :

"Invention is a concept; a thing evolved from the mind. It is not a revelation of something which exists and was unknown, but is the creation of something which did not exist before, possessing the elements of novelty and utility in kind and measure different from and greater than what the art might expect from its skilled workers."

Ten years later the Supreme Court employed the same reasoning in defining invention. It said in *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 77 L. Ed. 1114, 1119 (1933):

“It (invention) is the result of an inventive act, the birth of an idea, and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form. (Citing cases.)”

“Though the mental concept is embodied or realized in a mechanism or a physical or chemical aggregate, the embodiment is not the invention and is not the subject of a patent.”

The new inventive idea or concept of the Lanninger invention is that a *portable* flexible pipe line of rigid pipe could be provided, instantly adaptable for varying “irregularities of the ground” as moved from place to place or field to field, wherein readily releasable connectible and disconnectible joints will be sealed against leakage when subjected to the hydraulic pressures necessary for conveying water under pressure. It is particularly advantageous in showering, overhead or sprinkler irrigation, by putting sprinkler devices in the lengths of pipe. Some appreciation of the merit of Lanninger’s invention may be gained from a very plain mathematical calculation based on the testimony of Hanson (T. R. 353-356). Prior to the Lanninger invention overhead irrigation was practiced by permanently installed rigidly jointed pipes, requiring a row of pipes permanently jointed and permanently installed in rows about 40 feet apart.

The advance in that art may be visualized by considering what this meant in a single forty-acre field. Roughly, forty acres is 1350 feet by 1350 feet. That means about 34 rows of pipe, each 1350 feet long or 45,950 lineal feet of pipe. If Lanninger could do this with one row of portable pipe he would employ only one string of pipe 1350 feet long or only 3% of the required length of pipe, not to mention the additional fact that permanently installed pipe prevents ploughing and cultivating. On this feature alone the Lanninger invention demonstrates the quality of invention far greater than the Supreme Court found to be present in sustaining a combination of old elements in *Richmond Screw Anchor Co. v. United States* (1928), 275 U. S. 331, 72 L. Ed. 303:

“The record showed that a beam adaptable for the purpose weighed 3300 pounds. * * * Such modifications and their advantage were all very clear after the fact; but the old beams had been in use for a number of years and a heavy weight of metal had been used when, by Lenke’s device, it was cut down two-thirds.”

THE DISCLOSURE AND CLAIM IN SUIT.

The structure described in the patent is only one way to give a physical form to the new idea or concept as a demonstration of its utility. Having stated one physical form in which the idea or concept may be carried out advantageously, the patentee is entitled to claim his inventive concept broadly in all the physical forms in which it may be embodied. This principle

of patent law has been repeatedly reiterated, as instanced recently by the Supreme Court in 1935, in *Samuel B. Smith v. E. H. Snow, et al.*, 294 U. S. 1, 20, 79 L. Ed. 721, 732:

“We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor’s method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention. Paper Bag Patent Case (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*), 210 U. S. 405, 419, 52 L. Ed. 1122, 1128, 28 S. Ct. 748; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 116, 40 L. Ed. 358, 361, 16 S. Ct. 240; *Winans v. Denmead*, 15 How. 330, 343, 14 L. Ed. 717, 722.”

also:

Western Electric Co. v. La Rue, 139 U. S. 601, 35 L. Ed. 294;

Tilghman v. Proctor, 12 Otto 708, 102 U. S., 26 L. Ed. 279 at 287;

J. L. Owens Co. v. Twin City Separator Co., 168 Fed. 259 (C. C. A. 8th);

Vrooman v. Penhollow, 179 Fed. 296 (C. C. A. 6th).

THE CLAIM IN SUIT.

The complaint alleges infringement of claim 3 of the patent, and that claim only is relied upon by plaintiffs (T. R. 6 and 31). Broken into its elements, it comprises:

A pipe joint in connection with pipes, one of which has an unthreaded end,

a rigid coupling sleeve for coupling said pipes into which said unthreaded end extends, said sleeve having an interior annular groove in the inner surface,

a packing of elastic material in said coupling sleeve consisting of a free cylindrical part frictionally enclosing the unthreaded pipe end and having a flange frictionally retained in the groove of said sleeve,

and means for hingedly securing said sleeve on the pipe having the unthreaded end.

CLAIM 3 IS A VALID COMBINATION.

Claim 3 is a combination claim, and, as in every combination the individual elements may be wholly old, or wholly new, or partly old and partly new. This fact does not, however, detract from the merit of the inventive concept. Plaintiffs claim that the result itself is new; that never prior to Lanninger's invention, as shown by his application date in 1923, was it disclosed how a conduit line of rigid, unthreaded pipe lengths could be made to accomodate itself to irregularities of the ground in relatively secured relation while maintaining flexibility and ease of repeated connection and disconnection and a liquid-tight joint at couplings. But the result need not necessarily be even new, if an old result is accomplished in a more facile and efficient way by some joint operation performed by the elements producing a result due to their

cooperative action, an end result to which all the elements contribute.

Cantrell v. Wallick, 117 U. S. 689, 29 L. Ed. 1017:

“The first defense is based on the theory that a patent cannot be valid unless it is new in all its elements as well as in the combination, if it is for a combination. But this theory cannot be maintained.”

The requirements of a combination have been clearly stated by this Court in *Willard v. Union Tool Co.* (C. C. A. 9th), 253 Fed. 48:

“Nor is it necessary that the action of the elements be simultaneous. *Pelton Water Wheel Co. v. Doble*, 190 Fed. 760 (C.C.A. 9); *Burdette-Rowntree Mfg. Co. v. Standard Plunger E. Co.*, 196 Fed. 43; *Novelty Glass Mfg. Co. v. Brookfield* (C.C.A.), 170 Fed. 946; *Krell Auto Grand Piano Co. v. Story & Clark Co.* (C.C.A.), 207 Fed. 946. Nor is it necessary that one of the constituent elements shall so enter into the combination as to change the action of the others. *International Mausoleum Co. v. Sievert* (C.C.A.), 213 Fed. 225. *It is sufficient if there be some joint operation performed by the elements producing a result due to their cooperative action.* *National Cash Register Co. v. American Cash Register Co.* (C.C.A.), 53 Fed. 367; *Toledo Computing Scale Co. v. Moneyweight Scale Co.* (C. C. A.), 178 Fed. 557; *New York Scaffolding Co. v. Whitney* (C.C.A.), 224 Fed. 452; *Ohmer Fare Register Co. v. Ohmer* (C.C.A.), 238 Fed. 182. And the result itself need not be new. It is sufficient if an old result be produced in a more ‘facile, economical, or efficient way’. *New York Scaffolding Co. v.*

Whitney, *supra*; Pelton Water Wheel Co. v. Doble, *supra*.”

Dow Chemical Co. v. Williams Bros. Well Treating Co. (C.C.A. 10), 81 Fed. (2d) 495, 28 Pat. Qr. 243:

“It is contended that the patent consists of an aggregation of old ideas, and not a combination involving invention. This court has so recently explored this question it is unnecessary to till that ground again. *Independent Oil Well Cementing Co. v. Halliburton* (C.C.A. 10), 54 F. (2d) 896. See, also, Judge Booth’s excellent analysis in *Gray v. Texas Co.* (C.C.A. 8), 75 F. (2d) 606. We there held that a new combination of old elements was patentable, if the *conception involved invention*, and if a new result was produced, or an old result attained in a more facile, economical, and efficient way. In so holding, we but followed *Leeds v. Victor Talking Machine Co.*, 213 U.S. 301, where the Supreme Court held *l.c.* 318, that ‘A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new.’ We also held that a patentable combination of elements exists if by their reciprocal influence or joint and cooperate action on a common objective, a new result, or an old result in a more efficient way, is effected; such joint action need not be simultaneous nor constant.”

LANNINGER’S NEW USE OF FLEXIBLE JOINTS.

The prior art in the present case does not present a situation where such prior art patents may be considered anticipatory of the combination on the ground

that they are entitled to all uses to which they are capable of being put; no patent in the prior art disclosed the concept of Lanninger nor the means for carrying such a concept into effect. If it be admitted that the separate elements of claim 3 were old, yet the releasably secured flexibility of those elements disclosed a new combination capable of the new use of making rigid pipe and rigid sleeve couplings capable of irrigating undulating irregular ground by loosely connected unthreaded pipe. "In such cases it requires but little physical change to make an invention."

H. K. Regar & Sons, Inc. v. Scott & Williams, Inc.,
63 Fed. (2d) 229, 231 (C. C. A. 2):

"When old devices are changed at all, the change may be dictated *by a new conception, which it took originality to conceive*. Strictly, the old device is not then put to a new use; the new use begets a new device. *In such cases it requires but little physical change to make an invention.*"

COOPERATION OF ELEMENTS OF THE COMBINATION.

Let it be assumed that each individual element of claim 3 is to be found in some prior patent, some trade catalog or somewhere in public use. Yet, the combination in a relationship embodying the mental concept is not to be found anywhere; that is, there is not found in any prior art the new idea or concept of a pipe line in which lengths of rigid unthreaded pipe may be secured against pressure blow-outs, and yet maintain a leakproof, tight joint, without interfering with a hinged relationship of the pipes at the joint,

and at the same time retain the facility of connecting and disconnecting the joint to provide portability. In the patent in suit, and particularly within the provisions of claim 3, there is a cooperation of elements to effectuate this new and useful concept. The sleeve is rigid, adapting itself (as the patentee says), to withstand the rough handling to which they are submitted as the pipe lines are thrown about in the fields and in factories". At least one end of the sleeve is "smooth" and serves to receive the "rough" unthreaded pipe end, and likewise has an internal groove which serves to receive and hold an elastic packing member. That packing member consists of two integrally joined portions; one of those portions, the patent says, is held in a recess and provides "a specially simple fixation". Being "held" in the groove, it does not move out of the groove when the unthreaded pipe end is inserted or withdrawn, nor when the joined pipes have their opposite ends moved laterally. The flange also maintains a seal against the wall of the groove, regardless of what relative hinged movement occurs between the joined pipes; the other integral portion of the packing member is a free cylindrical part enclosing the unthreaded pipe end and moves with the pipe, constantly maintaining a seal against the unthreaded pipe end, regardless of the angular relation of the axis of the sleeve and the axis of the unthreaded pipe; that is, the flange portion of the packing remains co-axial with, and seals the sleeve, whereas, the free cylindrical portion of the packing member moves co-axially with, and seals against, the unthreaded pipe, the two portions

of the packing being the means by which "a certain degree of flexibility is imparted to the pipe line". (Exhibit 11 Tr. 385, patent page 1, line 26) and witness Vale (T. R. 107-112). There is yet another element of the combination consisting of means for hingedly securing the sleeve on the unthreaded pipe end. That this element cooperates with the other elements is demonstrated by defendants themselves when they stipulate (T. R. 31, 32, Par. 4), that defendants purchase the tubular portions of the couplings including the elastic gasket (Exhibits 3, 8, 47 and 48) from a Mr. Pierce and then, themselves, complete the combination of the claim by attaching the respective hook and latching lock of those exhibits. Those elements are certainly not added for esthetic effect, and would be added only and solely to make the other elements functionally and practically effective. Conduit lines employing this type of coupling are under considerable internal pressure. They cannot blow loose longitudinally in direct axial alignment because reinforced by a line of end-to-end pipe, but they will blow loose at the joint or coupling by moving laterally, unless positively held together (Vale, T. R. 118, Hanson T. R. 355). In a trench, as in buried gas and water mains, the problem is not so acute as the dirt provides a lateral buttress; in flood or surface irrigation there is no appreciable internal pressure. But this joint is for "the facility * * * to adapt itself to the irregularities of the ground", "especially for showering, irrigating" (Exhibit 11, T. R. 385, patent page 1, lines 73-74, and line 4). Therefore, the provision of a means to hold the pipes in juxtaposition,

without destroying the hinged relationship of the sleeve and inserted pipe end, nor devitalizing the two sealing factors of the elastic packing member. It is therefore apparent that there is cooperation between the rigid sleeve, the two integral portions of the unitary packing member, the unthreaded pipe end, and a means for securing the sleeve to the unthreaded pipe end while maintaining the flexibility. Each element may act according to the law of its own being, but each is capacitated to contribute to the common end.

San Francisco Bridge Co. v. Keating (C. C. A. 9), 68 Fed. 351, 354 (quoting from *National Cash Register Co. v. American Cash Register Co.* (C. C. A. 3), 53 Fed. 371:

“This suggestion (of aggregation) is based upon the allegation that each of the elements associated by Campbell does not qualify every other of them; but this is true only in the sense that each does not modify or change the characteristic mode of action or method of operation of the others. In doing its appointed share toward effecting the single result achieved by the cooperation of all, each element acts, of course, *according to the law of its own being*; but though, of necessity so acting, it is still none the less combined with the others, and does ‘qualify’ each and all of them (not their distinctive methods of operation), in the sense that each is, by the cooperation of the others, capacitated to contribute, by acting in its own peculiar way, to the common end, which, without the cooperation of each and every other of the coordinated elements, it would be powerless to accomplish or advance.”

Also, to the same effect :

H. J. Heinz v. Cohn (C. C. A. 9), 207 Fed. 547,
557 et seq.;

Sachs v. Hartford Electric Supply Co. (C. C. A.
2d), 47 Fed. (2d) 743, 8 Pat. Qr. 302.

A very apropos decision is the recent (1941) decision of this Court quoted below, dealing with the same general subject of the present suit—pipes and couplings or joints thereof. All the individual elements of the claim were old. The art was old and there was no new and meritorious concept of accomplishing a tremendously beneficial result such as was accomplished by the Lanninger invention. But, in structural elements, as in the Lanninger patent here in suit, there were old pipes, one received within another, with packing between the two, and functional relationship of slidability. The patentee accomplished something new as a beneficial result by most simple means. This Court said, *Payne Furnace and Supply Co. v. Williams-Wallace Co.* (C. C. A. 9, 1941) 117 Fed. (2d) 823:

“The invention disclosed, if invention there be, resides in the combination of known elements—namely, in a composite pipe section comprising an inner core pipe, an external pipe, and insulating material interposed between the two, plus the functional relationship of slidability of the inner pipe providing a construction in which, necessarily, the inner and outer stacks are supported independently of each other when the unit sections are joined together.

“The combination claimed as invention is as simple as it has proved useful * * *

“The flue pipe art is old, yet has its problems; and it would seem that Stadtfeld’s combination has overcome a number of important difficulties in this field. His pipe, as the trial court found, has gone into wide and successful use in the building industry. Appellant, with Stadtfeld’s work before it, has manufactured and put on the market an exact copy, and in its advertising matter has proclaimed as novel the features relied on by the patentee as disclosing invention.” * * * The patent is entitled to the presumption of validity; and the citations to the prior art fail to overcome the presumption.”

PRESUMPTION OF VALIDITY OF PATENT.

Not only is it demonstrated that a new and useful result is accomplished by the practical application of the structure of claim 3 of the Lanninger patent, but the patent is presumed to be valid, and presumed to be a valid combination until the contrary is proved by a defendant beyond a reasonable doubt. This proposition has been so repeatedly affirmed by this Court that mere citation of authority for the convenience of the Court is believed to be sufficient.

Seymour v. Osborne, 11 Wall. 516, 20 L. Ed. 33 (78 U. S.);

Cantrell v. Wallick, 117 U. S. 689, 29 L. Ed. 1017;

Schumacher v. Buttonlath Mfg. Co. (C. C. A. 9), 292 Fed. 522, 531;

- Reinharts, Inc. v. Caterpillar Tractor Co.* (C. C. A. 9), 85 Fed. (2d) 628, 630;
San Francisco Cornice Co. v. Beyrle (C. C. A. 9), 195 Fed. 516;
Kawneer Co. v. McHugh, et al. (C. C. A. 9), 51 Fed. (2d) 560, 562, 563;
Payne Furnace and Supply Co. v. Williams Wallace Co. (C. C. A. 9), 117 Fed. (2d) 823.
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PRESUMPTION OF VALIDITY IS EVEN STRONGER WHERE PATENT IS GRANTED OVER ART CITED BY A DEFENDANT.

With one exception, all of the prior patents in evidence were cited by the Patent Office during course of prosecution of the Lanninger application. (See File Wrapper, Defendants' Exhibit 45.) They are McGowan, 222,195 (Exh. 25, T. R. 391); Gorter, 580,084 (Exh. 32, T. R. 407); Anderson, 811,812 (Exh. 40, T. R. 433); Jones, 999,169 (Exh. 27, T. R. 395); Berry, 1,255,577 (Exh. 36, T. R. 413); Serrell, 1,292,524 (Exh. 39, T. R. 429); and Ward, 1,448,646 (Exh. 37, T. R. 423).

The one exception not cited by the Patent Office is the Patent to R. M. Close, 685,818 (Exh. 29, T. R. 401).

The presumption of validity is especially strong where the pertinent patents relied upon by defendants as an anticipation have been reviewed by the Patent Office and the patent in suit has been granted as having patentable novelty in the combination over rep-

representative types of patents relied upon by a defendant.

J. A. Mohr & Sons v. Alliance Securities Co. (C. C. A. 9), 14 Fed. (2d) 799:

“and the presumption that a patented combination is new and useful and embodies invention has added force where, as here, it appears that the patents relied upon as showing anticipation were considered by expert Patent Office officials. While their judgment is not absolutely binding on a Court, it is entitled to great weight and is to be overcome only by clear proof that they were mistaken and that the combination lacks patentable novelty. *Fairbanks v. Stickney*, 123 Fed. 79 (C. C. A.); *Hale and Kilburn Mfg. Co. v. Oneonta C. & R. S. Ry.* (C. C.), 129 Fed. 598; *MacClemmy v. Gilbert* (D. C.), 221 Fed. 73; *New Jersey Wire Cloth Co. v. Buffalo Expanded Metal Co.* (C. C.), 131 Fed. 265.”

To the same effect:

General Electric Co. v. Sava Sales Company (C.

C. A. 6th), 82 Fed. (2d) 100, 29 Pat. Qr. 59;

Gairing Tool Co. v. Eclipse Interchangeable

Counterbore Co., 48 Fed. (2d) 73, 75 (C. C.

A. 6);

Gordon Form Lathe Co. v. Walcott Machine

Co., 32 Fed. (2d) 55 (C. C. A. 6th);

Smokador Mfg. Co. v. Tubular Products Co.

(C. C. A. (2d) 31 Fed. (2d) 255.

SIMPLICITY DOES NOT NEGATIVE INVENTION.

The fact that the combination of elements may seem simple now in the light of the disclosure by Lanninger of a new concept for accomplishing a new and useful purpose does not negative the quality of invention at the time that Lanninger made his invention in 1922 and filed his application in the United States in 1923. The situation must be viewed in the light of the problem and the need twenty years ago. *Western Electric Co. Inc. v. Wallerstein* (C. C. A. 2), 60 Fed. (2d) 723, 15 Pat. Qr. 9:

“With the knowledge of today and the aid of curves actually obtained by using the negative grid voltage, it is now easy to reason that a negative grid bias should be used. But that is not the test of invention. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 31 Sup. Ct. 444, 55 Law. Ed. 527. *The test is what was known in the art in 1912 when Lowenstein made his invention.*”

Lakeside Cheese Co. v. Shefford Cheese Co. (C. C. A. 7), 72 Fed. (2d) 497, 23 Pat. Qr. 184;

Dow Chemical Co. v. Williams Bros. Well Treating Corp. (C. C. A. 10), 81 Fed. (2d) 495, 496-7.

Looking at the situation from the standpoint of the art in 1922 or 1923, it is apparent that those skilled in the art had failed to see or recognize the advantages of the combination of elements which Lanninger did recognize. A part of Lanninger's inventive concept lay in the fact that he recognized the ex-

istence of a problem, i. e., if an agriculturalist must buy 40,000 lineal feet of pipe to irrigate 40 acres of uneven land, then that land could not be irrigated from the financial standpoint. He recognized the cause of the lack of agricultural development of irregular ground, and he also discovered a means to overcome that problem with a line of portable surface conduits connectible and disconnectible in the field without tools, and flexibly jointed to adapt them to irregularities of the ground. Even though the Pierce patent (Exhibit 22, T. R. 387) does not disclose a flexible joint, defendants' expert witness McDougall, who prepared that application (T. R. 295), and who has been practicing the profession of mechanical engineer since 1907, stated in that patent in 1931 (eight years after Lanninger's filing date), "The problem here involved is many years old and many attempts have been made to solve it", and that "all previous devices have been commercial failures". Not only had Lanninger solved that problem at least eight years previously, but had provided a flexible joint in so doing. The recognition and solving of this problem by Lanninger is akin to the discovery of the problem of the patentee in the *Eibel Process Paper* case, in which the Supreme Court said:

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 67-68, 67 L. Ed. 523, 534:

"The fact that in a decade of an eager quest for higher speeds this important chain of circumstances had escaped observation, the fact that no one had applied a remedy for the consequent

trouble until Eibel, and the final fact that when he made known his discovery, all adopted his remedy, leave no doubt in our minds that what he saw and did was not obvious, and did involve discovery and invention.”

Consolidated v. Window Glass (C. C. A. 3), 261 Fed. 373:

“It is to be noted that the inventions made involve, as stated by Judge Thompson in the extract quoted above, the unusual feature of first locating or discovering the difficulty to be overcome and its relation to the whole problem, before any inventive steps were taken to solve it. In other words, these patents involve, so to speak, two series of inventions: First, discovering the difficulty; and, second, discovering means to overcome that difficulty.”

Miehle v. Whitlock (C. C. A. 2), 223 Fed. 647, 650:

“Patentable novelty is sometimes found in discovering what is the difficulty with an existing structure and what change in its elements will correct the difficulty, even though the means for introducing that element into the combination are old and their adaption to the new purpose involves no patentable novelty.”

That the patentee accomplished a new and useful result by what may now appear to be very simple means does not detract from the quality of invention, but, to the contrary, demonstrates the quality of invention. As this Court has said, *Kitchen v. Levison*, (C. C. A. 9), 188 Fed. 658:

“There may be the highest form of invention in some of the simplest improvements on the prior art.”

Snow v. Keller-Thomason (C. C. A. 9), 241
Fed. 119:

“Indeed, the most simple contrivances sometimes present the clearest examples of the product of inventive faculty.”

And see:

Webster Loom Co. v. Higgins, et al., 105 U. S.
580, 26 L. Ed. 1177, 1181;

Expanded Metal Co. v. Bradford, 214 U. S.
366, 53 L. Ed. 1034;

Potts v. Creager, 155 U. S. 597, 39 L. Ed. 275;

*Diamond Rubber Co. v. Consolidated Rubber
Tire Co.*, 220 U. S. 428;

Washburn v. Barbed Wire Co., 143 U. S. 275,
36 L. Ed. 154, 12 Sup. Ct. 443.

We sometimes hear it said in these later years that the Supreme Court has departed from the pristine doctrine that simplicity does not negative invention. But we do not believe that to be the case. In plain, simple terms, we believe the Supreme Court has said in substance, if you merely accomplish the same old thing which was done before, but do it by a change of mechanism, you must demonstrate a new idea of means which has a flash of genius of such character as to be beyond mechanical skill; but if you recognized an unsolved problem to be overcome and conceived a new idea to solve that problem, it makes no

difference how simple your means may be to carry your new concept into effect. Under such circumstances, the Supreme Court has not departed from the age-old classics of simplicity supporting invention of a high order, such as stated in *The Barbed Wire Patent* case (1892), 143 U. S. 275, 283, 36 L. Ed. 154, 158, and the *Collar Button* case (*Krementz v. Cottle*, 1893), 148 U. S. 556, 559, 37 L. Ed. 558, 559. Those cases have been repeatedly cited by the Supreme Court as authority and repeated at least as recently as 1935 in the decision delivered by the present Chief Justice Stone in *Smith v. Snow*, 294 U. S. 1, 79 L. Ed. 721, reversing the Eighth Circuit and affirming the Ninth Circuit (*Waxham v. Smith*, 294 U. S. 20, 79 L. Ed. 733), in a case in which the invention of the patent which was sustained as valid and infringed consisted of changing the prior art methods of egg incubation from the step of circulation of air by thermodynamics to mechanically impelled circulation, because the patentee had developed a new idea or concept that elimination of foul air and the conservation of moisture were desirable factors in increasing the efficiency of the incubation of eggs, a very old and highly developed art. This was only the carrying forward of the repeatedly affirmed principle of the so-called *Eibel Paper* case of 1923 (261 U. S. 45, 63, 67 L. Ed. 523, 532), the earlier *Morley Sewing Machine* case of 1888 (129 U. S. 263, 32 L. Ed. 715), and the still earlier gondola coal car case of *Winans v. Denmead* of 1853 (15 How. 341, 14 L. Ed. 721). For more than a hundred years this has been an authoritative principle settled by the Supreme

Court, and its reiteration in 1935 is not a new doctrine. The principle is masterfully stated in 1922 by the Supreme Court in the *Eibel Paper* case, and is particularly appropriate here because the problem involved was a recognition of difficulty encountered due to gravity flow of liquids. The mechanism employed in Eibel's invention was all old in a paper-making machine. Eibel did not add or subtract any new mechanical element. What he did was to recognize that an existing difficulty in rippling of paper in the making thereof was caused by the fact that the wire belt upon which the paper stock was fed was not synchronized in movement with the feed of the paper stock. This wire belt had previously been inclined downwardly from an elevation of about 3 inches for liquid drainage, and all Eibel did was to increase its incline by raising its end elevation from three inches to twelve to twenty inches, but not adding or subtracting any mechanical element to the paper-making machine—

“Accordingly he proposed to add to the former speed of the stock by substantially tilting up the wire and giving the stock the added force of the downhill flow” (p. 52).

“Eibel's high or substantial pitch was directed toward a wholly different object from that of the prior art” (p. 67).

“In administering the patent law the court first looks into the art to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent, to secure to the inventor the

reward he deserves. If what he has done works only a slight step forward, and that which he says is a discovery is on the border line between mere mechanical change and real invention, then his patent, if sustained, will be given a narrow scope, and infringement will be found only in approximate copies of the new device. It is this differing attitude of the courts toward genuine discoveries and slight improvements that reconciles the sometimes apparently conflicting instances of construing specifications and the finding of equivalents in alleged infringements. In the case before us, for the reasons we have already reviewed, we think that Eibel made a very useful discovery which has substantially advanced the art. His was not a pioneer patent, creating a new art; but a patent which is only an improvement on an old machine may be very meritorious and entitled to liberal treatment" (p. 63).

Now, of course, plaintiffs do not contend that Lanninger was the first to recognize the problem of conveying water in pipes over irregular ground, since that has been done for centuries; nor of the bell and spigot joint, nor of a hinged connection of pipes, nor of a flanged packing; nor of a means to secure pipe together. But Lanninger recognized the problem that in practical irrigation of irregular ground it was highly desirable that pipes with unthreaded or "rough ends" be employed for cheapness; portability to save duplication of permanently installed rigidly connected pipe; ease of connection and disconnection; flexibility at the joint; and maintenance of a tight joint. He knew, as had been known for centuries, that water required pressure to flow upwardly against the force

of gravity and that irregular ground had upward inclines as well as downward inclines. He did not have to state this in his patent. "That which is common and well known is as if it were written out in the patent and delineated in the drawings" (*Webster Loom Co. v. Higgins*, 105 U. S. 580, 586, 26 L. Ed. 1177, 1179). And he recognized that he must overcome that pressure and prevent the pipes from blowing apart, without destroying the other factors for solving his problem. Thereupon, he secured his coupling member or sleeve on the pipe having the unthreaded end. But he did not provide a rigid securing means such as the flanged pipe with bolt and nut. He provided "means for hingedly securing"—a means which would secure the sleeve on the unthreaded pipe end and preserve the flexibility and tightness of the joint. Thus, he provided means by which there might be accomplished overhead or sprinkler irrigation in a portable irrigating system which does not depend on gravity flow, but has hydraulic pressure and is therefore adapted to undulating ground. It was this new idea of possibilities, this new conception of utilizing irregular ground under portable artificial irrigation and the application of the remedy, for which Lanninger, like Eibel, was entitled to be rewarded in his patent.

COMMERCIAL SUCCESS.

In addition, the evidence establishes by stipulation that the plaintiffs have manufactured and sold large

quantities of devices like Exhibit 17, and Hanson's testimony (T. R. 360-361) discloses that the variations of structural form from the exact form of the Lanninger drawings are merely to facilitate economical manufacture in quantity, and so that the device may be galvanized against rusting, and the hot galvanizing drained from the sleeve and not fill the interior groove. But its mode of operation and its result is the same as Exhibit 70, which specifically conforms to the design of Fig. 1 of the Lanninger patent in suit. The device of the patent exemplified by Exhibit 17 has been sold in large quantities (T. R. 329-334) and has received favorable acceptance. This is more than mere commercial success which might be dependent upon adroit and successful advertising or good salesmanship; the people who gain a living from the soil do not buy irrigation installations on the whim of advertising. The commercial success is a demonstration by actual users that there was something novel and useful in the combination of the patent that they had not been able to obtain from the disclosures of the prior art.

Eibel Process Co. v. Minnesota & Ontario Paper Co. (1922), 261 U. S. 45:

“The fact that the Eibel pitch has thus been generally adopted in the paper-making business, and that the daily product in paper making has thus been increased at least 20 per cent over that which had been achieved before Eibel, is very weighty evidence to sustain the presumption from his patent that what he discovered and invented was new and useful.”

Research Products Co. v. Tretolite Co. (C. C. A. 9, 1939), 106 Fed. (2d) 530, 532:

“So great and immediate a success speaks strongly of invention, adding emphasis to the strong presumption of invention, raised by the issuance of the patent.”

And to the same effect,

Temco Elec. Motor Co. v. Apco Mfg. Co. (1928),
275 U.S. 319, 72 L. Ed. 298;

Owen v. Perkins Oil Well Cementing Co. (C. C. A. 9), 38 Fed. (2d) 30;

Sherman, Clay & Co. v. Searchlight Horn Co.,
214 Fed. 86 (C. C. A. 9);

Vacuum Cleaner Co. v. American Rotary Valve Co., 227 Fed. 998;

Graham Paper Co. v. International Paper Co.,
International Paper Co. v. Graham Paper Co., 46 Fed. (2d) 881, 884, 885;

Berry v. Robertson, 40 Fed. (2d) 915, 921.



**PLAINTIFFS' COMMERCIAL DEVICE OF EXHIBIT 17 IS MADE
ACCORDING TO THE LANNINGER DISCLOSURE.**

But defendants urge (Defendants' Brief, page 28) that the commercially successful device of Exhibit 17 is not made in accordance with claim 3 of the Lanninger patent. They concede that it contains all the elements except the “flange” packing (Defendants' Brief, page 28). *Knight's Mechanical Dictionary*, page 876 (photostat Exhibit 96), defines a flange as a rib or rim. It does not have to be of a particular shape

(Vale, T. R. 141); defendants' expert McDougall agrees that a "flange" may assume many diverse shapes (T. R. 177), where he says, "Now a flange is a rib or ridge", and he describes numerous shapes and uses; also "So a flange is always an outstanding part". Plaintiffs' witness Hanson says that the radially extended portion of the packing of Exhibit 17 is a "flange" (T. R. 357) and that the mode of operation is the same as in the Lanninger patent (T. R. 360). It is true that defendants' expert Mr. McDougall, when he is on his guard, says that Exhibit 17 has a "V section packing in principle *precisely the same thing as used in 48*" (or 47), the latter two exhibits being the type of the defendants' alleged infringing structures. Now, when Mr. McDougall is not so closely on guard, what does he clearly recognize as a "flange"? In his testimony (T. R. 321) relative to the prior art patent to Berry (Exhibit 36, T. R. 413), Mr. McDougall has no difficulty at all in readily recognizing a member as a "flange L", which form a "V section" with the part to which it is attached, though those parts happen to be made of metal (T. R. 321). A glance at the element "L" of Figs. 3 and 4 of Exhibit 36 (T. R. 416) will demonstrate that when defendants' expert is speaking casually as a mechanical engineer of nearly forty years experience, he refers to a protruding member as a "flange" when it makes a V section opening with its base. And again, take the testimony of defendants' second expert, Mr. Finkbeiner, a graduate mechanical engineer of nearly forty years experience;

on direct examination for which he is prepared, he states that Exhibit 4 is a "V type or U type packing", but when he is testifying extemporaneously about Exhibit 47 (defendants' accused structure), he spontaneously, and without any prompting, refers to the two joined legs of the packing of defendants' packing member (Exhibit 47) as "inside flange" and "outside flange", not once only, but repeatedly (T. R. 275-276). Bearing in mind that Mr. McDougall testified (T. R. 227) that the packing member of plaintiffs' Exhibit 17 is the same in principle as the packing member employed by defendants' structure, it follows that the packing member of Exhibit 17 must have a flange. It is also significant that defendants' witness Mr. Pierce, who made and sold defendants' coupling sleeve, including the packing therein (T. R. 31, par. 4), has no difficulty in recognizing this questioned part of the defendants' packing as an outer rim, which is within the definition of "flange" in *Knight's Mechanical Dictionary* (Exhibit 96). Since Mr. McDougall says the packing member of Exhibits 47 and 48 and Exhibit 17 are the same in principle, it follows that all of defendants' witnesses as well as plaintiffs' witnesses recognize that plaintiffs' commercial structure of Exhibit 17 and defendants' accused structures of Exhibits 47 and 48 all have a "packing of elastic material * * * having a flange frictionally retained in the groove of said sleeve", as set forth in claim 3 of the Lanninger patent. But it is not its name, but what it does which is the determining factor. As the Supreme Court said in *Sanitary Refrigerator Co. v. Winters* (1929), 280 U.S. 30, 41-43, 74 L. Ed. 147:

“if two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form or shape.”

Exhibit 17 may present features which are specific improvements on the specific structure of the Lanninger *drawings*, but it is within the Lanninger description and also claim 3. The familiar rules discussed elsewhere herein are (a) that change of form does not avoid a patent, and (b) that the later device of an improver may yet be within an earlier, broader patent. Commercial success may properly be attributed to the commercial structure, Exhibit 17, as being made and sold by license under Lanninger's patent, and as being one factor demonstrating validity of the Lanninger patent.

**PRIOR ART NEITHER NEGATIVES VALIDITY NOR
NARROWS CLAIM 3.**

In analysis of the prior art, defendants' brief (pages 17-26) points out where individual elements of claim 3 may be found in modified forms in prior patents and prior publications. But claim 3 of the Lanninger patent is a combination claim. Defendants' brief does not point to any patent disclosing the combination of claim 3, nor to any prior art disclosing a concept of accomplishing the new result of a flexible leak-proof joint in a line of rigid pipe loosely or releasably connectible and disconnectible for portability, and having means to secure them together in maintained flex-

ible pipe-forming relation under pressure of liquid therein.

Defendants' discussion of specification II (page 17 of Brief) is apparently divided into two headings. Under the first heading (page 17 of brief), there is discussed the subject of aggregation of individual elements found in various patents and publications. The second heading (page 22 of brief) discusses the subject of anticipation of the combination of claim 3. Defendants rely on only two prior patents as anticipating the combination. These are the Jones patent of 1911 (Exhibit 27, T. R. 395) and the Berry patent of 1918 (Exhibit 36, T. R. 413).

Referring to the Jones patent, No. 999,169, it is in a non-analogous art of couplings for flexible hose, and the trial Court so held. The reason the art is not analogous appears from the Jones patent itself, which shows no flexibility of the joint, since the hose itself has all the needed flexibility without the joint contributing thereto. Not one word in the Jones patent refers to any flexibility in the coupling; and the intimate metal to metal contact shown between the receiving "socket 14" and the inserted "plain portion 19" demonstrates that no such flexibility in the coupling was intended nor is it possible. However, the Jones patent, firstly, is not for a "pipe joint in connection with pipes", secondly, there is no flexibility in the "joint" and, therefore, no "means for hingedly securing" a rigid sleeve on an unthreaded pipe end, and thirdly, in the packing or gasket 21 of the Jones patent the free cylindrical part of the gasket does not

enclose the unthreaded pipe end, as admitted by defendants' expert (T. R. 196). The gasket, therefore, is not a means whereby "a certain degree of flexibility is imparted to the pipe line" (Lanninger patent, Col. 1, line 26, Exhibit 11, T. R. 397), cooperating with a means for hingedly securing the parts to preserve the flexibility.

The other patent relied on by defendants' brief (Brief page 24), is Berry patent, No. 1,255,577 of 1918 (Exhibit 36, T. R. 413). It is the patent in which a perfect V angle is formed by the part L (see Figs. 2, 3 and 4) and which is nevertheless designated a "flange" by defendants' witness McDougall, as previously discussed. The Berry patent is not within the inventive concept of Lanninger. It is for a series of joints permanently and mechanically connected, the end of the inserted pipe member F being *threaded* to engage other mechanism such as the metal collar H and the annular rings P and Q which hold therebetween the flange of a gasket or packing S. Defendants' brief (Brief page 24) describes this as a "reversed flange" in an "annular groove, this time on the exterior of the reduced portion of the pipe extending into the bell". But it will be noted that the packing or gasket S has nothing to do with the flexibility, the packing merely serving as a packing and the flexibility being provided solely by the convex surface W of stop-ring V bearing on stop-ring H. But even if the inventive concept of Lanninger were present in the Berry patent, the structure would not have anticipated claim 3 because the Berry structure does not have an interior annular groove in the sleeve member into

which the flange of the packing member is frictionally engaged. Defendants' Brief and evidence finds no difficulty in referring to the *clamped* flange of the packing in the Berry patent as being "frictionally retained in the groove" (Brief page 24, and T. R. 192), whereas in discussing the Lanninger patent (Brief page 30) and the file wrapper at page 32, a "flange clamped in the sleeve" is something entirely different from a flange frictionally held. A clamp is one form of frictional holding; defendants' witness McDougall says this is not misleading (T. R. 208). However, Lanninger illustrated two forms in his drawings, saying the flange was held in groove e, and as an option, if desired to make it adjustable, it *could* be clamped. The Lanninger claim 3 provides "said *sleeve* having an interior annular groove in the inner surface" and the packing "having a flange frictionally engaged in the groove of *said sleeve*". Yet defendants' witness Mr. McDougall admits, as he must, that this is not shown by Berry. Though he says it is the same old principle, but reversed, he admits he has not read the description (T. R. 321). In *Temco Elec. Motor Co. v. Apco Mfg. Co.*, 275 U.S. 319, 327, 72 L. Ed. 298, 301, the Supreme Court held reversal of parts of a spring "by turning over on its back" did not anticipate when the alleged anticipation as a whole did not accomplish the same result as the patented structure.

Though defendants apparently do not rely on the other prior patents for the defense of anticipation, a word will be added as to each one in evidence, though none are for accomplishing the same purpose as Lanninger disclosed.

The McGowan patent, No. 222,195 of 1879 (Exhibit 25, T. R. 391) provides a rotatable joint in a goose-neck of a standpipe for replenishing water to railway water tanks. Surely an art not analogous to a line of pipe over irregular ground. There is no testimony relative to the McGowan patent. It discloses a rotary swivelled connection E, and a goose-neck terminal section which will swing open on a pivot I, and a cushioned bumper M against which an end of the goose-neck abuts. There is no sleeve in the sense of the Lanninger patent, there is no interior annular groove in the inner surface of a sleeve and there is no gasket or packing held in such a groove, and the gasket does not enclose an unthreaded pipe end. Nor does the gasket have any adaptability for providing a "degree of flexibility" as stated as being the function of the gasket in Lanninger's specification.

The Close patent, No. 685,818 of 1901 (Exhibit 29, T. R. 401) was also lacking in any explanatory testimony, so that we are not informed what factors of anticipation are supposed to be present in this patent. There is nothing in the Close patent to in any way even suggest that a flexible joint is provided thereby. In fact, the sleeve is provided with an "internal central rib B against which the ends of the pipe abut when in place in the sleeve" (page 1, line 43). Referring to the drawing of that patent, it is to be noted that there is barely a sliding clearance between the sleeve and the inserted pipe end, and no mention of any intended clearance at all. Therefore, it is apparent that the inserted pipe end when fulcrumed on the edge of the opening in the sleeve could not have any

real or intended flexibility if its end was against the rib B and its circumference had a mere sliding clearance relative to the internal wall of the sleeve. When considering the stated purpose of "laying gas and water mains in cities", it is apparent that no flexibility was necessary, since the Court may certainly take judicial notice of the fact that water and gas mains in cities are not flexibly joined, but are layed underground and packed around with dirt. Therefore, they can be neither flexible nor subject to blowing apart under pressure by lateral movement of the joint. Wherefore, the Close patent does not need and does not disclose any means for hingedly securing the sleeve and pipe relatively.

The Gorter patent, No. 580,084 of 1897 is next in order of exhibits (Exhibit 32, T. R. 407). This patent is a slip-joint having a "smooth fit" metal to metal contact; it is not flexible, but rotatively swivels. Therefore, it has no hinged relationship of the pipe portions, and consequently, in securing the pipes together, "No, there is no hinged means there" (to quote defendant's witness, T. R. 184). And again, the same witness, when asked if he found anything in the Gorter patent mentioning flexibility or hingability of the joint, stated, "I don't find anything" (T. R. 313).

The Ward patent, No. 1,448,646 of 1923 (Exhibit 37, T. R. 423), hardly needs comment. There is no testimony relative to it, and defendants' brief does not discuss it. A mere glance at the drawing (T. R. 425), demonstrates it has no relevancy to the matters here in issue.

The Serrell patent, No. 1,292,524 of 1919, is not for a pipe joint in connection with pipes, but is a bathroom or kitchen accessory to connect a faucet with a flexible hose.

That the ruling of the trial Court was correct in excluding hose connections as not relevant is shown by defendant's expert witness as to this Serrell patent (T. R. 194):

“flexibility was not needed there if they were going to put a hose on right there.”

And again (T. R. 193):

“It does not have a hinged connection, merely having a set screw ‘6’ * * *

No, it is not shown flexible.”

Even if the Serrell patent were relevant, it is obvious from the patent itself, that if the set screws “6” are tight, there is no hingability and if they are loose, the device will not remain mounted on the faucet.

The Anderson patent, No. 811,812 of 1906 (Exhibit 40, T. R. 433) is in a remote art of railway stand pipes. There is nothing to indicate it would or could be used in a line of flexibly connected pipes over irregular ground.

It is not for the same purpose and insofar as it has one or two individual elements which by chance come within the literal wording of claim 3 of Laninger, its resemblance is accidental. While it does have a bell 5 and an unthreaded end of pipe 6 extending thereinto, the “means for hingedly securing” is a fixed means 9 secured by bolts and is not the same

securing means of Lanninger, who, though his claim merely refers to "means for hingedly securing", describes the means in his specification as being in conjunction and cooperation with an elastic gasket which serves to provide flexibility, and a readily connectible and disconnectible securing means provided by a "loosely inserted cotter pin d" and "the easy movement of the cotter pin in the borings of the hinge" (Exhibit 11, page 1, lines 66-72, T. R. 385).

But, even ignoring the difference of purpose or concept, the Anderson patent does not have an interior annular groove *in the sleeve or bell* with the flange of a gasket or packing held therein; it is the gasket and flange which provide flexibility in Lanninger, but not so in Anderson. To the contrary, the groove for holding the packing gasket of Anderson is on the exterior of the inserted pipe and the packing is held therein as an entirety by a coil spring 8 and a ring (not numbered), as shown in cross-section adjacent the reference character 7 in Fig. 4.

And that completes the prior art. There is not one patent in the entire group that indicates that those patentees made any pretense of accomplishing the purpose and idea of Lanninger, and none of them disclose the physical structure of the combination of claim 3. Likeness in some individual important particulars without accomplishing similar results, is not anticipation. *Consolidated Safety Valve Co. v. Crosby, et al.*, 113 U. S. 158, 28 L. Ed. 939 at 943.

"In regard to all of the above patents, adduced against Richardson's patent of 1866, it may be generally said, that they never were, in their day, and before the date of that patent or of Richard-

son's invention, known or recognized as producing any such result as his apparatus of that patent produces, as above defined. Likenesses in them, in physical structure, to the apparatus of Richardson, in important particulars may be pointed out, but it is only as the anatomy of a corpse resembles that of the living being. The prior structures never effected the kind of result attained by Richardson's apparatus, because they lacked the thing which gave success. * * *''

SEPARATE ELEMENTS GATHERED FROM MANY SOURCES
DO NOT ANTICIPATE.

It is usually very easy to search all of the mechanical devices in any art and find one element here and another there and another some place else, and then say that if all of these elements are brought into juxtaposed cooperative relationship to accomplish a new and useful result, it would involve only a transposition of parts, or that all the variations operate in the same way. But anticipation is not to be determined in that manner. *Parks v. Booth*, 12 Otto 96, 102 U. S. 96, 26 L. Ed. 54:

“Where the thing patented is an entirety, consisting of a separate device or of a single combination of old elements incapable of division or separate use, the respondent cannot make good the defense in question by proving that a part of the entire invention is found in one prior patent, printed publication or machine, and another part in another, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant.”

And as stated by this Court, *J. A. Mohr & Son v. Alliance Securities Co.* (C. C. A. 9), 14 Fed. (2d) 799:

“It will not do to say that the Fisher combination might by a slight modification be made to perform the same functions. It is to be borne in mind that the prior art here relied upon consists entirely of patents and that when it is sought by means of prior patents to ascertain the state of the art, nothing can be used except what is disclosed upon the face of those patents. They cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.”

See also:

Stebler v. Riverside Heights Orange Growers
(C. C. A. 9), 205 Fed. 735;

Payne Furnace & Supply Co. v. Williams-Wal-
lace Co. (C. C. A. 9, 1941), 114 Fed. (2d) 823;

Cadillac Motor Car Co. v. Austin, 225 Fed. 983
C. C. A. 6);

Owens Co. v. Twin City Separator Co. (C. C. A.
8), 168 Fed. 259.

**ANTICIPATING PATENTS MUST CLEARLY DISCLOSE
THE SAME INVENTIVE IDEA.**

Seymour v. Osborn, 78 U. S. 555;

Skelly Oil Co. v. Universal Oil Products Co.,
31 Fed. (2d) 427, 431 (C. C. A. 3rd);

Wellman, et al. v. Cramp, 3 Fed. (2d) 531 (C.
C. A. 6th);

A. B. Dick Co. v. Underwood Typewriter Co.,
246 Fed. 309, 312 (S. D. N. Y. 1917).

ACCIDENTAL RESULTS AND EMBRYONIC IDEAS
DO NOT ANTICIPATE.

Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 659,
661;

*Eibel Paper Co. v. Minnesota & Ontario Paper
Co.*, 261 U. S. 45, 66;

Tilghman v. Proctor, 102 U. S. 707, 26 L. Ed.
279;

Los Alamitos Sugar Co. v. Carroll (C. C. A. 9),
173 Fed. 280;

Electric Candy Machine Co. v. Morris, 156 Fed.
972;

*H. D. Smith & Co. v. Peck Stow and Wilcox
Co.* (C. C. A. 2), 262 Fed. 415;

Canda v. Michigan Malleable Iron Co., (C. C.
A. 6), 124 Fed. 486;

*United Verde Co. v. Pierce-Smith Converter
Co.* (C. C. A. 3), 7 Fed. (2d) 13, 16;

Pittsburgh Reduction Co. v. Cowles, 55 Fed.
301, 307;

Wickelmann v. Dick (C. C. A. 2), 88 Fed. 264,
266 and 267.

It is manifest that there is nothing in the prior art to anticipate the Lanninger patent in suit. It is presumed to be valid and that presumption has not been overcome beyond a reasonable doubt, nor by a preponderance of evidence, nor by any evidence at all. It not only meets every historical rule for a valid patent, but meets the much discussed principle of a "flash of genius" in providing means whereby irrigation may be accessible to thousands of acres of fertile but irregular ground at a price which is

practically possible. No one prior to Lanninger had this “flash of genius”.

It is believed that that observation on the quality of invention is in substance a rule long observed, and previously quoted herein, “the birth of an idea * * * a concept demonstrated to be true by practical application or embodiment in tangible form”, a new concept beyond mechanical skill and reduced to practical form to make it available and useful by novel means.

Trabon Engineering Corp. v. Dirkes (C. C. A. 6, 1943), Advance Sheets U. S. Pat. Quar. of July 17, 1943, Vol. 58, page 97) :

“We do not interpret the observation as indicating anything more significant than that the quality of invention is ‘something more’ than expected mechanical skill. Nor do we read the phrase as another conscious effort to define the indefinable.”

Had Lanninger’s patent entered an old and highly developed field or been for a mere change in physical structure to accomplish an old result, there might have been grounds for application of the “mechanical skill” doctrine, but the prior art shows no prior conception of Lanninger’s idea for “showering and irrigating” “over irregular ground” by a flexible portable rigid pipe system. The invention, therefore, involves more than mechanical skill and includes “the birth of an idea * * * a concept demonstrated to be true by practical application or embodiment in tangible form” by means not disclosed in any prior art.

SPECIFICATION I—FLEXIBLE HOSE COUPLINGS ARE
NON-ANALOGOUS ART.

Before leaving the subject of anticipation, it seems in logical order to discuss defendants' first specification of error, which is that the trial Court erred in declining to consider the art of coupling flexible hose as analogous to the art of flexible couplings for lines of pipe. The District Court admitted the first two patents offered on flexible hose couplings (Serrell, Exhibit 39, and Jones, Exhibit 27), both of which demonstrated that the problem to be overcome was not the same as in the Lanninger patent, and the Court thereupon commented that the art was non-analogous (T. R. 198). The defendants' witness McDougall testified as to the Serrell patent that it is not shown as a flexible coupling (T. R. 193) and that "the flexibility evidently was not needed there if they were going to put a hose on right there" (T. R. 194).

Defendants acquiesced in the ruling of the Court and did not offer further hose couplings in evidence. Rule 43(c) provides the procedure available when evidence is excluded, but the provisions of that rule were not invoked by defendants. Obviously, Rule 43(c) is a necessary and salutary one for the orderly consideration of appeals; otherwise, a party may seek a reversal of a judgment on conjecture of what might have been offered and yet was not.

The problem of analogous and non-analogous art is a difficult one to define objectively. After analysis of the cases the Supreme Court said in *Potts v. Creager*, 155 U. S. 597, 39 L. Ed. 275, a case which

involved change of glass bars to steel bars on the periphery of a grinding cylinder:

“but if the relation between them (the arts) be remote, and *especially if the new use of the old device produce a new result*, it may at least involve an exercise of the inventive faculty.”

* * * * *

“Not only did they discard the glass bars, and substitute others of steel, but *they substituted them for a purpose wholly different* from that for which they had been employed. * * * The result appears to have been a new and valuable one—so much so that within a short time thereafter, defendants themselves obtained a patent upon a machine of their own to accomplish it.”

(And Pierce, manufacturer of defendants’ coupling sleeve and gasket, paid Lanninger’s patent the same tribute (Exhibits 22 and 56)). A “purpose wholly different” in which “the result appears to have been a new and valuable one” would seem to be a safe guide in the present case. Specific cases may be cited in large numbers, but the particular devices involved furnish little guide as to other particular devices. A few cases of non-analogous art are cited in a footnote.¹ The rule in the *Potts-Creager* case appears to have been the rule followed recently by the Supreme Court in invalidating the patent for transferring the use of

¹*Lakewood Engineering Co. v. Walker* (C. C. A. 6, 1928), 23 Fed. (2d) 623; *Western Electric v. LaRue*, 139 U. S. 601, 35 L. Ed. 294; *General Co. v. Bullock* (C. C. A. 6), 152 Fed. 427; *Aiken v. National Tube Co.* (C. C. A. 6), 163 Fed. 254; *Herman v. Youngstown* (C. C. A. 6), 191 Fed. 579; *Lyonan v. Bassick* (C. C. A. 6), 18 Fed. (2d) 29.

a thermostat from electric toasters and irons to a cigarette lighter. The problem, the purpose and mode of operation of the thermostat was the same and the result was the same. If a thermostatically controlled toaster were made smaller, it would serve as a cigarette lighter; if the cigarette lighter were made larger, it would serve as a toaster. There was no difference in problem. It was only a difference in size and a difference of whether a slice of bread or a cigarette was placed in proximity to the heated resistance wire. But difference of problem and purpose meets the rationale of practically all the decided cases.

“The *problem* which the manufacturer of barrels had to solve was one of an entirely different nature from that which confronted the maker of a tin can or of a paint pail; * * * it is essential that the Patent Office, as well as this court, have in mind the *problem* which the inventor was attempting to solve.” (*In re Bennett* (C. C. P. A. 1933), 65 Fed. (2d) 144.)

And so, in comparing air sprayers for oil with air sprayers for paint, the Court said, *W. N. Matthews Corp. v. Alliance Securities* (C. C. A. 8, 1930), 40 Fed. (2d) 879:

“Therefore, it is important to know what he (the inventor) was searching for. Hopkins was interested in a paint air brush. * * * *His problem was made by the conditions and difficulties pertaining to paint air brushes.* He was trying to meet those conditions.”

On the same reasoning, the Circuit Court of Appeals for the Sixth Circuit has recently held that rolls for

paper-making were not in an analogous art with rollers for clothes wringers, fruit presses and for reducing wood pulp, saying, "We think that the only pertinent prior art is that of the earlier paper rolls" (*Cincinnati Rubber Mfg. Co. v. Stowe Woodward, Inc.* (C. C. A. 6, 1940), 111 Fed. (2d) 239.) Also, this Court held in 1942 that, "There is no analogy between the shaping of raw rubber in a mold to form a solid rubber tire and the art of retreading a tire carcass of fabric or cord" (*Super Mold Corp. v. Bacon* (C. C. A. 9, 1942), 130 Fed. (2d) 860.)

True, a pipe and a hose will both convey liquid, but this invention is not for a pipe or a hose, but for "a pipe joint in connection with pipes one of which has an unthreaded end", wherein the joint or coupling provides the only flexibility in the line, whereas a hose line with a non-flexible joint is in an opposite art wherein the line is flexible and the joint is not. Or, as defendants' witness McDougall aptly states "flexibility evidently was not needed there". The "problem to solve" was not the same, the "purpose wholly different", and "the result appears to have been a new and valuable one", evidenced, if in no other way, by the same criterion set by the Supreme Court in the *Potts-Creager* case where the defendant claimed to be operating under a later patent on a similar device.

LANNINGER PATENT ENTITLED TO LIBERAL CONSTRUCTION.

Lanninger's means to solve the problem may have been as simple in physical structure as was Eibel's

raising of the breast roll of a paper making machine somewhat higher than it had previously been raised, yet he made a meritorious invention which is entitled to liberal treatment.

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 67 L. Ed. at 532:

“In administering the patent law the court first looks into the art to find what the real *merit* of the alleged discovery or invention is and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent to secure to the inventor the reward he deserves.”

And also in affirming this Court in *Waxham v. Smith*, 294 U. S. 20, in deciding a companion case, the Supreme Court said in *Samuel B. Smith v. E. H. Snow, et al.* (1935), 294 U. S. 1, 20, 79 L. Ed. 721, 732:

“If the matter (of broad or narrow construction), were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made. (Citing cases.) * * * In such circumstances, if the claim were fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention, rather than to adopt a construction fatal to the grant.”

To the same effect:

Klein v. Russell, 19 Wall. 433, 466, 86 U. S. 117, 22 L. Ed. 117;

Topliff v. Topliff, 145 U. S. 156, 171, 36 L. Ed. 658, 664;

Providence Rubber Co. v. Goodyear, 76 U. S. 788, 19 L. Ed. 566 at 568;

Keystone Mfg. Co. v. Adams, 151 U. S. 139, 14 Sup. Ct. 295, 38 L. Ed. 103, 104;

Reinharts, Inc. v. Caterpillar Tractor (C. C. A. 9), 85 Fed. (2d) 628.

SPECIFICATION III—FILE WRAPPER OF LANNINGER PATENT.

Defendants' claim (Brief p. 30) that the file wrapper (Exhibit 45), demonstrates that Lanninger restricted the scope of his claims, and particularly claim 3, so that it cannot be construed to cover defendants' devices. This contention presupposes that defendants' devices do not have a "flange frictionally retained in the groove of said sleeve" (a fact on which the trial Court made a finding adverse to defendants), and that in the file wrapper Lanninger surrendered the novelty of such an element in his combination, except as limited to a right-angled flange. A contrary situation is shown by the file wrapper. Lanninger particularly and specifically pointed out to the Patent Office that he was claiming as an element of his combination in claim 2 (original claim 12) a clamped flange as shown in Fig. 3, and a frictionally retained flange, as shown also in Fig. 3, and in Figs 1 and 4.

Referring to the Lanninger File Wrapper (Exhibit 45), the first paragraph of the original description defines the invention broadly as including rubber packing cups. The second paragraph on page 1 states that

there is a certain "salient feature". That does not mean an *exclusive* feature. In ordinary language it usually means prominent or noticeable. "The salient *feature* (stated in the singular) is that the coupling sleeves are rigid and have cups of elastic material the neck of each cup fitting tightly on the corresponding pipe end." That description of "the salient feature" is shown in every illustration in the drawings. Then, following a comma, it is provided that the cups have "further", (that is "going beyond" or "additional to" the salient feature), "a flange which is clamped in the casing". And this "clamped" flange is shown in the drawings in only one place in the left hand portion of Fig. 3. In every other illustration the flange is shown held in the groove with no mechanically adjustable clamping, and the first paragraph on page 4 of the file wrapper clearly indicates that a mechanical clamp is intended only as an alternative form of holding the packing in the sleeve when it is desired to have it adjustably maintained there, in which event the flange could be clamped between two movable members. The defendant's expert witness recognized that a clamped flange was one form of a frictionally held flange in testifying relative to both the Berry patent (Exhibit 36) and Jones patent (Exhibit 27), when he says (T. R. 192 and 196) that the mechanically clamped flange of the packing in both those patents are "flanges frictionally retained in the groove of the sleeve".

There is no inconsistency in the file wrapper in the contention by Lanninger relative to the Anderson pat-

ent. In paper No. 11 of August 23, 1928, the Examiner rejected claims 12 and 13 on the Anderson patent. Claim 12 is the present allowed claim 2 and claim 13 is the present allowed claim 3 in suit. Claim 12 (allowed claim 2) contained the element "means for clamping the flange of said cup-shaped packing in the sleeve", whereas, claim 13 (allowed claim 3 in suit) originally provided for a "flange clamped in the groove", but was amended by paper No. 12, to read, "frictionally retained in the groove". In paper 12, under "Remarks", the applicant was arguing for allowance of the two claims 12 and 13. He did not say that the Anderson packing did not have a flange; in effect he admitted that the Anderson packing had a flange, but not a flange *clamped in the sleeve and a free portion extending into the sleeve and frictionally engaging the unthreaded end of the pipe*. He then states that it is obvious that the Lanninger application provides a packing means enclosed in the sleeve, and points out that both claim 12 (providing for a *clamped* flange) and claim 13 (providing for a *frictionally retained* flange) "*are generic to the same modification of the invention*", which is perfectly apparent from Fig. 3 (original Fig. 6) of the drawing showing both types of holding the flange. Then he specifically calls that difference in holding means to the attention of the Examiner by stating that in claim 13 (now claim 3 in suit) the sleeve is "*formed with a groove frictionally retaining the flange of the packing*" whereas "claim 12 defines the sleeve as including means for clamping the flange in the sleeve."

Far from being 100% variance between Lanninger's contention in the file wrapper and the testimony of Vale and Hanson, there is 100% accord. Lanninger relinquished nothing in the file wrapper. The fact that his claim 3 (old 13) is broader than claim 2 (old 12) detracts nothing from the breadth to which it is entitled. Neither defendants nor anyone else makes any showing of any intervening rights between the date of original filing of Lanninger's application in 1923 and granting of claim 3 in 1930.

Smith v. Snow, 294 U. S. 1 at 16; 79 L. Ed. 721 at 730:

“It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader claim 1.”

See also *Payne Furnace v. Williams-Wallace Co.* (C. C. A. 9th), 117 Fed. (2d) 823.

The patent describes and exemplifies one, and even two ways to practice the invention. The patentee may broadly claim all other ways in which his invention may be reduced to practice.

Smith v. Snow, *supra*;

Reinharts, Inc. v. Caterpillar Tractor Co. (C. C. A. 9), 85 Fed. (2d) 628;

G. H. Packwood Mfg. Co. v. St. Louis Janitor Supply Co. (C. C. A. 8, 1940), 115 Fed. (2d) 958.

DEFENDANT'S CONTENTION OF ESTOPPEL BY
EXHIBITS 87 AND 88.

Appellant's contention at pages 35-37 of Brief are novel, to say the least. Assuming *arguendo* that in 1939 the appellee, California Corrugated Culvert Co., was a licensee under Pierce patent No. 1,945,293 (a fact that is not shown by the record), what they did by the letter Exhibit 87-J (T. R. 239), was to review the additional Pierce application (Exhibit 88A) and suggest claims to Pierce which were limited to a specific structure having an interior lock (Exhibit 82). At no time and at no place did they say that such a device would avoid infringement of the dominating claims of the Lanninger patent. If by chance the Pierce idea of an internal lock proved to be patentable and proved to be a successful commercial device, California Corrugated Culvert Co., would have a license, so that it would have protection under the broader and earlier Lanninger patent and also the later and specific Pierce application (Exhibit '88), if granted. In an endeavor to assist Pierce to obtain claims on his specific structure, California Corrugated Culvert Co. suggested certain claims to be inserted in which the "connecting means" was "within said sleeve and independent thereof". That application was rejected by the Patent Office, but if it had been allowed, it would still have been for a structure within the broader earlier claims of the Lanninger patent, and California Corrugated Culvert Co. could not have made or used the specific later development of Pierce without license thereunder. This is merely a recognition of the time-honored rule that a later patentee is not excused from

infringement of an earlier broader patent, and that the earlier patentee may not use the specific means of the later patent without license. Illustrative of a long line of cases, are *Temco Elec. Motor Co. v. Apco Mfg. Co.*, 275 U. S. 319, 328; 72 L. Ed. 298, 302; *Simplex v. Hauser* (C. C. A. 9), 248 Fed. 919; *Bake-Rite Mfg. Co. v. Tomlinson* (C. C. A. 9), 16 Fed. (2d) 556.

But the additional fault of this defense is that the letter (Exhibit 87-J) was written to Mr. McDougall in a separate and specific matter. It did not appoint him an agent of the writer to make representations to third parties which would be binding on California Corrugated Culvert Co. Whatever he did in that respect he did of his own volition and on his own responsibility acting independently.

And in addition, it is to be noted that when defendants undertook to manufacture and sell the devices of Exhibits 3, 8, 47 and 48, they did not employ the interior hooks of the proposed Pierce improvement, but instead took the sleeves which were manufactured by Pierce without any securing means, and then completed the structure of claim 3 by adding the exterior securing means thereto, as shown by Lanninger. There is no evidence that plaintiffs ever stood by and permitted defendants to manufacture and sell devices of Exhibits 47 and 48, without protest, nor that plaintiffs did any act or made any representation to defendants that their devices would not or did not come within the earlier patent to Lanninger. Therefore, the cases cited by defendants' brief are not in point.

INFRINGEMENT.

Appellants' brief is predicated on the admission that all elements of the combination of claim 3 are found in appellant's devices except a packing member having a flange frictionally held in an internal groove of the sleeve.

Finding of Fact XII (T. R. 72) covers this determination by the trial court. Federal Rule of Civil Procedure No. 52 (a) provides that such findings shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. As heretofore discussed relative to commercial success of plaintiffs' commercial device of Exhibit 17, appellants' witness McDougall testifies (T. R. 227) that the radially outwardly extending rim of the packing of plaintiffs' device (Exhibit 17) and also the packing of defendants' devices (Exhibits 47 and 48), do not have flanges because they are V-shaped packings; yet in analyzing the Berry patent of the prior art (T. R. 190 and 321) he readily describes as a "flange" the ring member "L" which makes a *V-shaped connection* with the enlarged sleeve member D with an angle almost identical with a cross-section of defendants' packing gasket. Again (T. R. 205-206) the same witness testifies that defendants' devices (Exhibits 47 and 48) do not have an interior *annular* groove, because it is a bell end with a half round groove. He prepared the claims of the Pierce patent of Exhibit 22, according to which the exhibits 47 and 48 are claimed to be made; and in claim 1 of the Pierce pat-

ent that same witness described that groove as “an *annular* internal semi-circular section groove” (T. R. 305). Defendant’s witness Mr. Finkbeiner says of Exhibit 47, “That is an *annular* groove around there”, (T. R. 275). As to the flange on the packing member, it will be noted at Transcript of Record page 275 that *plaintiffs’* counsel in referring to defendants’ device (Exhibit 47) carefully avoided referring to the outer rim of defendants’ packing as a “flange”, but described the packing portions as the “inner” and “outer” portions, yet the defendants’ witness himself voluntarily adopts the term “flange” for those portions. Both witnesses when testifying for the purpose on which they were called as experts studiously maintain that if there is a V-shape or a U-shape, there is no flange, but when their testimony is casual and not studied, they both find no difficulty in saying a V-shaped connection provides a flange, and that defendants’ devices have an internal annular groove to hold that flange.

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 53; 67 L. Ed. 523, 528:

“A case that can be made out in all its elements by cross examination of opposing witnesses is a strong case. Implication of facts and conditions falling from the mouths of witnesses, when only collateral to the exact point of inquiry for which they are called, is generally the most trustworthy evidence, because the result of the natural, so to say, subconscious adherence to the truth, uninfluenced by a knowledge or perception of the bearing of the implication on the ultimate issue in the case.”

Defendants' witnesses contradict themselves and contradict each other.

The trial court was able to hear and see the witnesses, and on that basis determined as a fact that the radially extending rims of the packing members of the Lanninger patent and the defendants' devices, Exhibits 47 and 48, were "flanges" frictionally retained in a groove and that they operated in the same way to accomplish the same results by substantially similar means (T. R. 63 and 73). It is urged that the evidence amply supports the findings and that under Rule 52 (a) the findings should not be disturbed.

Reinharts, Inc. v. Caterpillar Tractor Co. (C. C. A 9), 85 Fed. (2d) 628.

The testimony of witnesses Vale (T. R. 120-125) and Hanson (T. R. 360-364) amply demonstrates that the packing member of Exhibits 47 and 48 operate in the same manner as is described in the Lanninger patent and that there is a flange frictionally retained in an internal annular groove of the sleeve. There is no denial of inclusion of any of the other elements of claim 3. The testimony of defendants' witness Mr. Pierce (T. R. 342-349), who manufactures the sleeve and packing for defendants, amply demonstrates that there is a tight fit between the rim or flange of the packing and the internal groove of the sleeve, to provide a seal and that the packing also permits flexibility. The defendants themselves attach the means to hingedly secure the sleeve on the unthreaded pipe end, comprising the lug and latch in Exhibit 48 and the notch and hook of Exhibit 47,

both of which secure the sleeve on the unthreaded pipe end and maintain them secured while still permitting the flexibility which Mr. Pierce built into the joint. The testimony by Mr. Finkbeiner (T. R. 273), endeavors to show that defendants' packing is not frictionally held in the groove because it is held by the shape of the groove with a reasonably tight fit. That is what the Lanninger patent says of the packing, that it is "held in a recess e"; that it is a "specially simple fixation as it is inserted and clamped in a groove"; but if it is optionally desired to make the clamping of the flange adjustable, the front wall and the rear wall of the groove may be relatively movable by means of threads p of Fig. 3. And Mr. Finkbeiner further says (T. R. 274), defendants' packing could not fall out because of the shape of the groove, and neither could Lanninger's fall out because it is "held in a recess e". Lanninger describes his fit as a clamped fit in the groove and he can optionally make the clamp adjustable, whereas, Mr. Finkbeiner (T. R. 274), and Mr. Pierce (T. R. 343, 344), say that the packing of defendants' devices (Exhibits 47, 48) are held in the groove and fit tightly and are purposely made so. They all provide flexibility and make a seal against leakage when water pressure is in the pipe line. In fact, Mr. Finkbeiner demonstrates with defendants' packing member (Exhibit 4), how, when the unthreaded pipe end is inserted (T. R. 288), the much vaunted "V" of defendants' packing is closed up from the bottom angle for three-quarters of the depth of the "V", and the closed portion of the "V" becomes a mere slit, or

as the Court expressed it, "just like overlapping lips pressed tightly against each other and then the whole against the groove" (T. R. 289).

This is a case where the defendants urge that every individual element and also the combination of the Lanninger patent is found in the prior art, but then discard the prior art devices and copy the Lanninger patent.

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 441, 55 L. Ed. 527, 534:

"The prior art was open to the rubber company. That 'art was crowded', it says, 'with numerous prototypes and predecessors' of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done."

Farmers Handy Wagon Co. v. Beaver Silo & Box Mfg. Co. (C. C. A. 7), 236 Fed. 731, 738:

"Appellee, having overlooked the silos of the prior art and openly appropriated that of the patent, must, by reason of its tribute implied in its almost literal annexation of the device, come somewhat limpingly to the contest against its validity. It certainly concedes its utility."

The functioning of defendants' coupling sleeve and packing are described in the catalogue of Mr. Pierce,

the manufacturer (Exhibit 56, page 1, exclusive of the cover page),

“It makes a permanently tight joint, which takes care of all expansion strains and being very flexible allows the pipe line to conform to the contour of the ground and variations of alignment.”

Lanninger says of his invention (Exhibit 11, T. R. 383, p. 1, lines 22-27),

“According to the invention this difficulty is overcome by using the elastic packings through which not only is a tight joint capable of being maintained but a certain degree of flexibility is imparted to the pipe line.”

and that his securing means is to

“further increase the flexibility of the joint of the pipes and the facility of this joint to adapt itself to the irregularities of the ground and the available space.”

These appraisals of the respective devices could almost be substituted one for the other.

Lanninger made a meritorius invention; defendants may have made changes in shapes of parts, and may call them by a different name, but they accomplish the same thing in the same way by substantially the same means and effectuated by the same materials operated by the same physical forces.

Winans v. Denmead, 15 How. 330, 342, 14 L. Ed. 717 at 722:

“And therefore, the patentee, having described his invention, and shown its principles, and

claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied * * *”

Winans v. Denmead not only has the respect due to its statement as “a familiar rule” by the Supreme Court in 1853, but it has been followed down the years and reiterated in various forms.

Sanitary Refrigerator Co. v. Winters (1929),
280 U. S. 30, 74 L. Ed. 147, 3 Pat. Q. 40:

“Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. (Citing cases.) That mere colorable departures from the patented device do not avoid infringement, see *McCormick v. Talcott*, 20 How. 402, 405, 15 L. Ed. 930, 931. A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement. *Ives v. Hamilton*, 92 U. S. 426, 430, 23 L. Ed. 494, 495.”

While defendants have somewhat changed the form of the packing element as illustrated in the Lanninger patent, they have adopted the idea of means which is determinative of identity of principle.

Consolidated Safety Valve Co. v. Crosby etc.

Valve Co., 113 U. S. 157, 28 L. Ed. 939, 946:

“When the ideas necessary to success are made known, and a structure embodying those ideas is given to the world, it is easy for the skilful mechanic to vary the form, by mechanism which is equivalent and is, therefore, in a case of this kind, an infringement.”

Butler v. Burch Plow Co., 23 Fed. (2d) 15
(C.C.A. 9):

“Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form, or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain its results by the use of the same or equivalent mechanical means.”

See also:

Reinharts, Inc. v. Caterpillar Tractor Co. (C.C. A. 9), 85 Fed. (2d) 628, 632, 634, 636;

Parker v. Automatic Machine Co., 227 Fed. 449, 452 (No. Dist. Calif.).

CLAIM LANGUAGE NOT IGNORED BY TRIAL COURT.

At page 44 of appellants' brief at paragraph numbered "4", appellants urge that the trial Court ignored the language of claim 3. Lanninger could have as well designated his "flange" member as an integral outwardly extending rim or rib or a radially outwardly

extended collar. He would still have been within the common definition of a flange. But his specification and his drawings indicate clearly that his co-called "flange" is that portion of a packing member, regardless of its name, which holds the packing member in an interior annular groove in the sleeve and provides flexibility for an unthreaded pipe end inserted through a central opening in the packing. But the basis of appellants' whole theory of claim language is predicated on a false premise. Lanninger does not say in his specification nor in his claim that he employs a "flange packing". He says he uses an "elastic packing", a "packing cup", a "rubber cup", "a hat shaped rubber packing". Then he describes that element as having a "flange". It is believed that the previously cited decisions of the Supreme Court and of this Court amply support the findings of the trial Court that it is the function, purpose and mode of operation which determines similarity and infringement rather than the names or forms of things.

**DEFENDANTS' CLAIM THAT THEIR DEVICES ARE MADE
UNDER PIERCE PATENT No. 1,945,293.**

Defendants claimed that their devices of Exhibits 3, 8, 47 and 48 were manufactured and sold under Pierce Patent No. 1,945,293, granted January 30, 1934, applied for in 1931, eight years after the Lanninger application of 1923. The Pierce patent (Exhibit 22) does not disclose a word as to providing a flexible

joint, and the closeness of the inserted pipe end 9 to the interior wall of the casing as shown adjacent the numeral "8a" indicates that no flexibility was intended, but merely a sealing gasket in a closely fitted joint.

But it is well settled that a later patent does not authorize the later inventor and later patentee to infringe the earlier patent of an earlier inventor.

Sanitary Refrigerator Co. v. Winters, 280 U. S. 30, 74 L. Ed. 147;

Temco Elec. Motor Co. v. Apco Mfg. Co., 275 U. S. 319, 72 L. Ed. 298;

Simplex Window Co. v. Hauser R. W. Co., 248 Fed. 919 (C.C.A. 9);

Bake-Rite Mfg. Co. v. Tomlinson, 16 Fed. (2d) 556 (C.C.A. 9).

CONCLUSION.

It is again urged that Lanninger was a pioneer in the inventive concept of providing a flexible leak-proof joint in a line of rigid pipe and produced a meritorious invention; that he reduced it to practice by a novel combination of elements; that the utility of his invention is demonstrated by both commercial success and imitation by appellants; that there is nothing in the prior art which even resembles it in concept or structure, and that the appellants have infringed claim 3 by a substantial duplication of both concept and means; that the findings and conclusions of the trial

Court should not be disturbed, and that the interlocutory decree should be affirmed.

Dated, August 9, 1943.

Respectfully submitted,

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